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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/467,646	12/20/1999	ANTHONY F. HERBST	NEWMRKTP99-4	2648

7590 12/19/2002

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EXAMINER

BUI, THACH H

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/467,646

Applicant(s)

HERBST ET AL.

Examiner

Thach H Bui

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed November 4, 2002 has been received and entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9-11, 19, 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 is vague and indefinite because there is no clear or proper antecedent basis for "checking for errors made in said specifying" recited in line 2. What is specified? Is it a custom set of investment or the rule that specified?

Claim 19 is vague and indefinite because "the step of entering a function of at least one from a group consisting of a market condition and a change in a market condition" renders the claim unclear. Is function equal to market condition and/or change in market condition?

Claim 30 is vague and indefinite because there is no clear or proper antecedent basis for "carried out subject". What is the subject?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-31, 33, 35-40, 43-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parsons (U.S. Patent No. 6,411,939).

As per claim 1, Parsons teaches a computer aid method for operating investment fund (equity asset investments, interest-bearing assets and etc), comprising a computer network having multiple computers connect to the central computer (see Figures 1 and 2) (column 5, lines 30-36) (column 5, lines 48-53) (column 6, lines 57-62) (column 8, line 55-column 10, line 10) (column 30, lines 3-62) and a means for outputting the investment account within the fund (column 32, lines 57-63) (column 34, lines 1-7).

Parsons does not explicitly mention a custom set of investments for a fund. However, Parsons teaches a means wherein the participant/user is presented a menu of products and services from which to choose those that are most of interest or best suits the participant's needs (column 38, lines 36-56) (see Figure 19). Therefore, it would have been obvious to one skilled artisan in the art to realize that the system, as taught by Parsons, has a custom set of investments and/or client's rule for a fund from a participant. In addition, it would have been obvious to one skilled artisan in the art to understand that there are multiple digital signals are being sent and received within the computer network reflecting the acquisitions of the investments.

As per claims 2-8 and 19, the claims contain features addressed in the above claims, and therefore, are rejected under the same rationale.

As per claims 9-13, Parsons teaches a means for checking error and prompt messages (column 10, lines 43-46). Furthermore, parson also teaches a compliance computer (66) to ensure compliance with the specifying rule; therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to have rules i.e. limiting a minimum amount of any investments, client's rule for the set of investments and etc.

As per claims 14-18, Parsons teaches a computer aid method for operating investment fund comprising a computer network (multiple computers connect to a central computer) having a database (storing information) (13) (column 10, lines 11-13). The computer network is capable in receiving/retrieving inputs and/or custom set of investments (as mentioned above) in implementing the transaction order i.e. rebalancing, changes in market condition and etc.

As per claims 20-24, Parsons has all the features of the invention, but Parsons does not mention explicitly cash management account system and the second client rules/second custom set of investments. However, Parsons teaches multiple computer systems having multiple software to manage multiple functions i.e. investments, contributions, payout benefits and etc. Therefore, it would have been obvious to one skilled artisan in the art to add a cash management account into the system, as taught by Parsons. In addition, it would have been obvious to one skilled artisan in the art to have a second set of client rules/custom set of investment added to the system.

As per claims 25-31, Parsons does not explicitly mention buying and selling orders at current market price. However, Parsons teaches a means for accessing asset

values daily (column 30, lines 3-11) and the system is performing in a real time manner (column 167, line 42). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a means for buying and selling orders at current market price, in real time.

As per claims 33 and 43-51, the claims contain feature addressed in the above claims, and therefore, are rejected under the same rationale.

As per claim 35, Parsons teaches a computer network including an investment manager and/or fund manager (column 34, line 18) (column 38, line 36-column 39, line 29) connect to a client terminal/participant for communicating investment management data.

As per claims 37-40, the claims contain features addressed in the above claims, and therefore, are rejected under the same rationale. In addition, the claims recite an insurance company computer system and a banking computer system. Parsons teaches a policy administering computer system to administer policy values (column 12, line 61-column 13, line 10). Furthermore, Parsons teaches a banking computer system for transferring and monitoring the assets and/or investments.

4. Claim 32, 34, 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parsons in view of Austin (U.S. Patent No. 6,157,924).

As per claim 32, Parsons has all the features of the invention but lacks the teaching of a web page. Austin teaches a web page for displaying information. It would have been obvious to one having ordinary skill in the art at the time the invention was

made to combine the teaching of Austin and Parsons so that the system can display the investments on a web page.

As per claim 34, Austin teaches a computer network comprising a central computer/server connects to a brokerage house and/or brokerage computer system.

As per claim 42, Parsons teaches a database for storing consisting of participant/client retirement age.

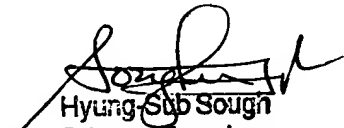
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thach H Bui whose telephone number is 703-305-0063. The examiner can normally be reached on Monday-Friday, 7:30-4 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough, can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

T.B.
December 12, 2002


Hyung-Sob Sough
Primary Examiner